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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,691	07/07/2003	Michael D. Kobrehel	11361.85367	7424

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EXAMINER	
ESTREMSKY, GARY WAYNE	
ART UNIT	**PAPER NUMBER**
3676	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/614,691	KOBREHEL, MICHAEL D.	
	Examiner	Art Unit	
	Gary W Estremsky	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *07 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *23-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 23-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,688,659 to Kobrehel. Although the conflicting claims are not identical, they are not patentably distinct from each other because when properly interpreted in light of the specification, the claims cover the same inventive subject matter as the claims of the Patent.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 23-25, 30, 31, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,083,419 to Pennington.

Penningtom '419 teaches Applicant's claim limitations including : a "pane" – as shown on the face of the Patent, a "latch bolt housing" – 78, "mounted to the pane" – as shown, a "latch bolt" – including 110, "adapted for compound sliding movment" – explicitly disclosed for a combination of linear and rotary sliding motion "in a plane substantially parallel to the plane of the pane" a "biasing member" – 98, a "release handle" – end portions 114.

As regards the 'compound sliding movement' limitation, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In order to expedite prosecution as much as possible, a reference explicitly disclosing compound sliding movement has been relied upon. However, it is suggested that the claim be amended to positively recite the structure that is required to perform the recited function. See MPEP 2114 and 2173.05(p), section II. The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

As regards claim 25, (alternatively to part 78) part 86 reads on "latch bolt housing" where plain meaning of "mounted to the pane" is broad enough to include indirect mounting arrangements, for example those other than being –mounted directly on the pane--. By analogy, even though a tire may be mounted to a wheel that is mounted on a hub on an axle mounted to a suspension bolted to a car, it is commonly accepted that 'the tire is mounted to the car'.

As regards claim 31, Pennington '419 teaches "shoulder" – at 60.

Allowable Subject Matter

5. While double-patenting rejections prevent indication of allowable subject matter at this time, it is noted that dependent claims 26, 27, 29, 32, 42 and independent claims 28, 34-41, 43 are not rejected using other prior art.

Response to Arguments

6. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Regardless, as those arguments might apply against the new grounds of rejection, it is the examiner's position that:

"mounted to the pane" is broad enough to include indirect mounting as discussed in the grounds of rejection;

the term "remote" does not define any particular structure that can be relied upon to patentably define from the well known structure of the prior art where relevant handle structure of the reference is arranged at a location distant from the latch bolt. The claim does not require any particular range of distance or particular structure, etc. that might be relied upon to patentably define from illustrated structure of the prior art;

limitation of "compound sliding movement" cannot be interpreted as narrowly as argued by Applicant (to require a path identical to that illustrated) but must be interpreted in accordance with its broadest reasonable interpretation consistent with case law and corresponding policy (the limitation cannot be given weight in accordance with 35 USC 112, 6th par as implied by arguments. See MPEP 2181-2185. The latch bolt of the reference slides in a combination of linear and rotary movements. Finally, it is suggested that particular structure corresponding to the 'adapted for compound sliding movement' be added to the claim since current limitation may be interpreted more broadly than current grounds of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 3,984,135 to Dathe.

U.S. Pat. No. 5,085,019 to Herpen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary W Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary W Estremsky
Examiner
Art Unit 3677